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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------------------------|-------------|----------------------|---------------------|------------------|
| 10/767,120 | 01/28/2004 | Bertrand Teplitzky | SS-747-01 | 4416 |
| 7590 | 07/22/2005 | | | EXAMINER |
| LAW OFFICES OF THOMAS E. SCHATZEL | | | BLOUNT, ERIC | |
| A Professional Corporation | | | ART UNIT | PAPER NUMBER |
| Suite 240 | | | | 2636 |
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| Los Gatos, CA 95032-2547 | | | | |

DATE MAILED: 07/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SM

| | | |
|------------------------------|-----------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/767,120 | TEPLITXKY ET AL. |
| | Examiner | Art Unit |
| | Eric M. Blount | 2636 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 28 January 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-14 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-14 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 28 January 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claim 6 recites the limitation "said physical measurement" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3 and 6-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gustafson [U.S. Patent No. 6,050,622] in view of Soehnlen [U.S. Pub No. 2002/0067264 A1].

Regarding **claims 1 and 7**, Gustafson discloses a retrofit product security system comprising a radio frequency identification means (20) embedded with a unique code (column 3, lines 39-41) responsive to a wireless interrogation by a reader (column 3, lines 42-45). An antenna is connected to the radio frequency identification means and is tuned to operate at a particular frequency and support the wireless interrogation (column 3, lines 48-60). The radio frequency identification means (20) is attached to a first product packaging part and means are provided for obviating attempts to remove

the antenna. An antenna is attached to a second product packaging part (column 4, line 60 – column 5, line 13). Gustafson does not specifically disclose that radio frequency identification means are attached by thermosetting cross-linked polymers. However, Gustafson teaches the use of an adhesive to permanently attach the radio frequency identification means and antenna to a product package. It would have been obvious to one of ordinary skill that the adhesive serves the same purpose as thermosetting and is one of many obvious choices that could have been used to attach the radio frequency means and antenna to the product package. Opposing sides of the package seen in Figures 3A-3C are considered product-packaging parts. A third product packaging part is disclosed for providing access and is bridged by the antenna connecting to the radio frequency identification means wherein an opening of the third product packing part breaks the antenna and renders the radio frequency identification means inoperable (Figures 3A-3C and column 5, lines 1-12). Gustafson does not specifically disclose that an RFID chip embedded with a serial number is used in the invention.

In an analogous art, Soehnlen discloses a product security system comprising an RFID chip embedded with a unique serial number and responsive to wireless interrogation by a reader (paragraphs 8 and 27).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to modify the invention of Gustafson to include the RFID components taught by Soehnlen because the modification would result in a product security system with more programming versatility and identification information.

As for **claim 2**, both Gustafson (column 3, lines 43-45) and Soehnlen (paragraph 27) disclose a reader used for wireless interrogation of the radio frequency identification means via the antenna and wirelessly collecting a unique code.

As for **claims 3 and 6**, Soehnlen teaches that it was well known in the art at the time of invention by applicant for RFID systems to include a database of unique serial numbers and their association with particular protected products originally supplied in a product container (paragraphs 18-20). It would have been obvious to one of ordinary skill in the art at the time of the invention that a database could store any type of information associated with a particular product.

Regarding **claim 8**, the combination of Gustafson and Soehnlen teach the limitations set forth by the claim (See claims 1 and 7 above). It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant that information could be associated with a unique serial number in a database (see claims 3 and 6). Likewise, from the disclosure, if the reader, upon interrogating a particular radio frequency identification means, receives a unique code, it is obvious that a product package would be considered safe. Though the radio frequency identification means and antenna are not embedded into the product package, it would have been an obvious modification given the knowledge of RFID technology at the time of the invention by applicant. Please see the list of cited references for examples of inventions with embedded RFID components.

As for **claim 9**, the step of collecting will fail to report a unique serial number if the product package has been entered (Gustafson, column 4, lines 48-52 and Soehnlen, paragraph 9).

Regarding **claim 10**, Gustafson discloses that an interrogator is used for inspecting a product package for evidence of tampering with radio frequency identification means or the antenna (column 3, lines 52-59).

As for **claim 11**, the step of collecting will fail to report a unique code if the product package has been tampered with enough to ruin the antenna (Gustafson, column 4, lines 48-52).

As for **claim 12**, it has been shown that Gustafson discloses a radio frequency identification means and an antenna for placement on a product. Any attempt to physically access them after manufacture will be visibly obvious to a consumer (column 7-column 9).

5. Claims 4-5 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gustafson in view of Soehnlen as applied to the claims above, and further in view of Egli et al [Pub No. US 2004/0245205 A1].

As for **claims 4 and 5**, neither Gustafson nor Soehnlen disclose a sensor for placement inside a product container. In an analogous art, Egli discloses a secure product packaging system wherein a sensor is placed inside a container and connected to a radio frequency identification means for providing physical measurements and wirelessly reporting an attribute of an originally supplied protected product within

(paragraph 77). Egli is used to show that it was known in the art to attach a sensor for measuring a parameter to a radio frequency identification means for transmitting and storing information. It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to modify the inventions of Gustafson and Soehnlen to include a sensor for sensing the parameters of a product within a package to ensure that a monitored product is safe and/or authentic, as taught by Egli.

Regarding **claims 13 and 14**, Egli discloses a method wherein a sensor is placed in contact with a product enclosed by a product package. Changes in a physical characteristic of the product are reported via radio frequency identification means as indicated by the sensor (See, claims 4 and 5 above).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. All cited references disclose security and/or breach detection systems using RF technology. Though not used in an art rejection, these inventions were useful during the examination of the present application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric M. Blount whose telephone number is (571) 272-2973. The examiner can normally be reached on 8:00 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Hofsass can be reached on (571) 272-2981. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Eric M. Blount
Examiner
Art Unit 2636

Jeffrey Hofsass
JEFFERY HOFSS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600